

REMARKS

Applicants wish to thank Examiner Wilder and Examiner Zitomer for their courtesy extended in granting a personal interview in this case held on May 31, 2001, and for their kind consideration and helpfulness in reviewing the proposed new claims. Applicants have canceled previously pending claims 1-14 and have added new claims 15-55. Therefore claims 15-55 are currently pending.

The invention

Applicants have invented diagnostic test kits and as probes for hybridization, or for use as primers for determining mutations, especially deletions of relatively large stretches of nucleotides in genes associated with hereditary types of cancer, particularly in the BRCA1 gene. The probes are complementary to at least one stretch of nucleotides of the target gene in the sense or the anti-sense direction and may be used in various detection methods, such as hybridization or polymerase chain reaction (PCR) methods.

The probes may flank one or both sides of a deletion and in certain embodiments may comprise a fusion of two sequences adjacent to the site of a deletion of a stretch of nucleotides, such as for instance, between two ALU-elements of the BRCA1 gene. Probes that detect deletions of at least a major part of any one or all of exons 13, 14, 15 and 16, or at least a major part of exon 22 are disclosed.

The probes of the invention are useful for detecting the presence of breast cancer and for detecting predisposition for breast cancer. In particular, the probes may be used in the detection of deletions that cause frame shift mutations, termination mutations or deletions of a stretch of nucleotides between two ALU-elements.

Finally, the invention also provides a method for determining the presence of a deletion of a stretch of nucleotides derived from the BRCA1 gene in a sample by contacting a sample with at least one probe which alone or together with a second means for detecting a deletion within the BRCA1 gene, allowing hybridization to occur and detecting the hybridization product.

The rejections based on 35 U.S.C. §112 raised in the Office Action of December 6, 2000

In the office action of December 6, 2000 the Examiner recited several grounds of rejection based on 35 U.S.C. §112, second paragraph each of which is addressed below.

At paragraph 4a of the office action, claims 1-11 were rejected as allegedly indefinite for the recitation of “a means.” According to the Examiner, the term “a means” is not properly defined in the specification and one of ordinary skill would not recognize the scope of the claimed invention.

In response, Applicants assert that the term “a means” is in fact clearly defined in the specification and the skilled artisan would indeed appreciate the scope of the claims. The specification is replete with examples of the use of “a means” for detecting deletions of a stretch of nucleotides from a BRCA1 gene. For example, at page 6, lines 3-15 of the specification, several hybridization-based and PCR-based probes are disclosed as suitable means for detecting a deletion of a stretch of nucleotides from a BRCA1 gene in a sample.

From these and other examples provided in the specification, the skilled artisan would readily appreciate these and other suitable means for detecting a deletion of a stretch of nucleotides from a BRCA1 gene in a sample. Therefore, Applicants believe that the term “a means” as applied in the claims is clear and definite, and respectfully requests that this rejection be withdrawn.

At paragraph 4b of the office action, claims 6-12 were rejected as allegedly indefinite for the recitation of “anyone” of the foregoing claims.

In response, Applicants have cancelled claims 6-12 and added new claims 15-55, none of which recite the offending language. Therefore, Applicants respectfully request that this rejection be withdrawn.

At paragraph 4c, claims 7-13 were rejected as allegedly indefinite for the recitation of “major part” as applied to the specified exons or sequences. According to the Examiner, the

term is not defined in the claim nor is a standard for ascertaining the requisite degree provided in the specification. Further, the Examiner states that one of ordinary skill would not recognize the scope of the invention.

In response, Applicants assert that the term “major part” has its usual and customary meaning, i.e. more than 50% of the whole. See the only applicable definition (2) of “major *adj*” in Meriam Webster’s Ninth New Collegiate Dictionary, 1990, Meriam Webster Inc., Springfield, MA. Definition 2: The adjective “major” is defined as: “greater in number, quantity or extent <the ~ part of his work>”(Attached as Exhibit 1).

As applied to the present specification and claims, the usual and customary meaning of “major part” clearly refers to the greater part in number of nucleotides (i.e. quantity or extent) of the nucleotide sequence to which it refers. Therefore, Applicants assert that the term “major part” is clear and definite and allows the skilled artisan to recognize the scope of the claimed invention and respectfully requests that this rejection be withdrawn.

At paragraph 4d of the office action, claim 8 was rejected as allegedly indefinite for lack of antecedent basis in the recitation “nucleotides 1396-1662.”

In response, Applicants have cancelled claim 8 and added new claims 15-55, none of which recite the offending language. Therefore, Applicants respectfully request that this rejection be withdrawn.

At paragraph 4e, claim 14 was rejected as allegedly indefinite for the recitation of “other means.” According to the Examiner, the term “other means” is not defined in the specification or claims and it cannot be determined to what Applicant is making reference.

In response, Applicants have cancelled claim 14 and added new claims 15-55, none of which recite the term “other means.” Therefore, Applicants respectfully request that this rejection be withdrawn.

At the second paragraph labelled as 4d (sic), the Examiner alleges that claim 14 is confusing in that it recites “is capable of” because it cannot be determined whether “capable of” is a property of the probe or of the said “other means.” The Examiner goes on to suggest changing “is capable of distinguishing” to “which distinguishes.”

In response, Applicants respectfully point out that claim 14 has been canceled and none of the new claims, 15-55 recite the “capable of” language. Therefore the rejection is moot and should be withdrawn, which action is respectfully requested.

At paragraph 4f, claim 14 the Examiner alleged that the recitation of “identifying the hybridization product” lacked proper antecedent basis because the hybridization conditions have not been identified and the prior steps do not indicate that hybridization has taken place.

Further, the Examiner stated that the term “possible” is unclear in the context of the language used in claim 14.

In response, Applicants point out that claim 14 has been canceled and the corresponding new claim (claim 55) clearly recites the proper antecedent basis for “identifying the hybridization product” and nowhere incorporates the term “possible.” The rejection is therefore moot. Applicants respectfully request that this rejection be withdrawn.

The rejections based on 35 U.S.C. §102 raised in the Office Action of December 6, 2000

At paragraph 6 of the office action the Examiner rejected claims 1-3 and 14 as allegedly being anticipated by Skolnick et al. (EP 0 699 754 A1, published on March 6, 1996) under the patent statutes at 35 U.S.C. §102(b).

According to the Examiner, Skolnick et al. teach a method and kit for detecting predisposition to breast and ovarian cancers, wherein the diagnostic techniques include detection of mutational events of the BRCA1 locus involving deletions, insertions and point mutations within the coding sequences and non-coding sequences of the genes, thereby anticipating the invention of claim 1.

Further, the Examiner states that the inventions of claims 2 and 3 are anticipated by the Skolnick et al. teachings of a kit comprising at least one probe for hybridization, and of a kit comprising the necessary elements for Southern blotting, respectively.

Lastly, the Examiner states that the invention as recited in claim 14, drawn to a method for determining the presence in a sample of a nucleic acid derived from a BRCA1 gene having an alteration, wherein said alteration is a deletion, comprising contacting said sample with at least one probe capable of distinguishing between BRCA1 genes having the alteration and genes not having the alteration, allowing for hybridization between said probe and nucleic acid and identifying the hybridization product, according to the present application, is anticipated by the recitation of claims 1-9 and 22 of the Skolnick et al. reference.

In response, Applicants point out that claims 1-3 and 14 have been canceled and new claims 15-55 have been added. The new claims 15, 16 and 17 correspond to original claims 1-3 respectively, and claim 55 corresponds to original claim 14. Each of these new claims recites the limitation that the deletion to be detected comprises at least a major part of any one or all of exons 13, 14, 15, and 16, or at least a major part of exon 22.

Skolnick et al. relates to methods and materials used to detect a human breast and ovarian cancer predisposing gene (BRCA1) – See Abstract. However, the Skolnick et al. reference does not disclose the specific deletions of the BRCA1 gene recited in claims 15-55 of the present invention. Even more importantly, Skolnick et al. could not have detected the deletions that are detected by the presently claimed methods because “Such mutations are difficult, if not impossible, to detect by the current[ly] PCR-based approach (if their

occurrence or the site thereof is unknown) using genomic DNA as template, which has been most widely applied to establish the current mutation spectrum of BRCA1.” (present specification at page 5, line 32-page 6, line 2). The present specification provided the first disclosure of the existence and detection of the specific deletions as recited in claims 15-55. Therefore Skolnick et al. can not have anticipated, let alone enablingly taught, a probe for hybridization or the necessary elements for Southern blotting for a diagnostic kit according to the pending claims of the present invention.

In summary, nowhere in the Skolnick et al. reference is there any teaching of deletions of at least a major part of any one or all of exons 13, 14, 15, and 16, or at least a major part of exon 22. Applicants therefore assert that claims 15-55 are novel over Skolnick et al. and respectfully request that this rejection be withdrawn.

At paragraph 8 of the office action the Examiner rejected claims 1-5 and 11-14 as allegedly being anticipated by Swensen et al. (U.S. patent 6,150,514, with an effective filing date of April 9, 1997) under the patent statutes at 35 U.S.C. §102(e).

According to the Examiner, the Swensen et al. reference anticipates claim 1 in that it teaches a method and diagnostic kit for detecting the presence of predisposition to breast and ovarian cancers, whereby a means is provided for detecting a deletion of a stretch of nucleotides from a BRCA1 gene in a sample.

The Examiner also asserted that claims 2 and 3 are anticipated by the teachings of Swensen et al. of at least one probe for hybridization and the necessary elements for Southern blotting.

Further, the Examiner asserted that claims 4 and 5 are anticipated by the teachings of Swensen et al. of a probe comprising sequences complementary to sequences on both sides of the deletion in the BRCA1 gene and wherein the deletion comprises one or more exons.

Further still, the Examiner asserted that claim 11 is anticipated by the teachings of Swensen et al. of a deletion comprising a stretch of nucleotides between two ALU elements.

Yet further, the Examiner asserted that claims 12 and 13 are anticipated by the teachings of Swensen et al. of probes for use in a diagnostic kit comprising a nucleic acid sequence which is a fusion of two ALU elements of the BRCA1 gene.

Lastly, the Examiner asserted that claim 14 is anticipated by the teachings of Swensen et al. of a method for determining the presence in a sample of a nucleic acid derived from the BRCA1 gene having a deletion of a stretch of nucleotides, exactly as recited in claim 14.

In response, Applicants point out that claims 1-5 and 11-14 have been canceled and new claims 15-55 have been added. The new claims 15-24 and 31-54 correspond to original claims 1-5 and 11-13, respectively. Claim 55 corresponds to original claim 14. Each of these

new claims recites the limitation that the deletion detected comprises at least a major part of any one or all of exons 13, 14, 15, and 16, or at least a major part of exon 22.

Swensen et al. describes a 14Kb deletion, which removes the promoter region of BRCA1 and includes exons 1a, 1b and 2. There is no disclosure of a probe or diagnostic kit for detecting the presence of or predisposition for breast cancer, whereby a means is provided for detecting deletions comprising at least a major part of any one or all of exons 13, 14, 15, and 16, or at least a major part of exon 22, as recited in the pending claims. Therefore none of claims 15-55 are anticipated by the Swensen et al. reference. Applicants therefore respectfully request that this rejection be withdrawn.

The rejection based on 35 U.S.C. §103 raised in the Office Action of December 6, 2000

At paragraph 10 of the office action the Examiner rejected claims 1, 2 4-6 and 11-13 as allegedly unpatentable over Puget et al. (Cancer Research, published in March, 1997) in view of Ahern (The Scientist, July 1995) under the patent statutes at 35 U.S.C. §103(a).

According to the Examiner, the method for detecting predisposition to breast cancer of Puget et al. differs from that of the claimed invention in that Puget et al. do not teach a kit for practicing the method. The Examiner points to the Ahern article for the teaching that a kit provides convenience, time management and ease of practicing to the investigator. Therefore, the Examiner opines, it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have provided the method of detecting

predisposition to cancer as taught by Puget et al. in the form of a kit for overall convenience and ease of practicing as taught by Ahern.

In response, Applicants point out that claims 1, 2, 4-6 and 11-13 have been canceled and new claims 15-55 have been added. The new claims 15, 16 and 18-30 correspond to original claims 1, 2 and 4-6, respectively. Claims 31-54 correspond to original claims 11-13. Each of these new claims recites the limitation that the deletion to be detected comprises at least a major part of any one or all of exons 13, 14, 15, and 16, or at least a major part of exon 22.

Applicants assert that up until the time the present invention was made, the deletions of the BRCA1 gene comprising at least a major part of any one or all of exons 13, 14, 15 and 16, or at least a major part of exon 22, detected by the currently claimed kits and probes, using the claimed methods, had not been disclosed, and more importantly were not predicted by the Puget et al. or by the Ahern references.

Thus, even if the cited references are combined, the combination falls short of the presently claimed invention. Therefore, Applicants respectfully request that the rejection for obviousness, based on the combination of Puget et al. in view of Ahern, be withdrawn.

Sequence Listing

The Office Action of December 6, 2000 contained a Notice to Comply with the Requirements for Patent Applications Containing Nucleotide Sequences and/or Amino Acid Sequence Disclosures. In response, Applicants have appended hereto an appropriately corrected SEQUENCE LISTING and Computer readable form (CRF).

Formal Drawings

The Office Action of December 6, 2000 also contained a Notice of Draftperson's Patent Drawing Review requiring new formal figures 1 and 3.

Applicant will provide appropriate drawings to correct these informalities at the time of allowance of claims from this application.

Support for new claims 15-55

New claims 15-55 are fully supported by the claims as originally filed and no new matter has been added by this amendment.

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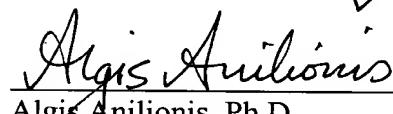


This Response is filed within six months of the December 6, 2000 Office Action. Accordingly, a Petition for a Three Month Extension of Time and the appropriate fee are filed concurrently herewith.

The assignee is a small entity. Therefore, the reduced fee for the extension of time is being submitted herewith.

If the Examiner has any questions relating to this Amendment or to this application in general, it is respectfully requested that the Examiner contact the Applicants' undersigned attorney at the telephone number provided below.

Respectfully submitted,


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VERSION OF AMENDMENT WITH MARKINGS TO SHOW CHANGES MADE

In the specification

At page 5 please replace the paragraph which begins at line 9 and continues to page 6 line 2 with the following divided paragraphs between which the heading “SUMMARY OF THE INVENTION” is inserted:

– – An intriguing feature of BRCA1, and unexpected in the light of Knudson’s two-hit inactivation theorem for tumor suppressor genes, is that somatically acquired mutations are extremely rare in ovarian tumors [34-38] and have in fact not yet been detected in 135 breast tumors [39-40]. This might indicate that inactivation of BRCA1 is not selected for during tumorigenesis of the non-inherited form of breast cancer. BRCA1 expression might be critical only during certain stages of tissue development, e.g., during puberty when the breast undergoes its final differentiation into a potential milk-producing gland [39]. However, others have argued that the mechanism of inactivation might be different from that seen in inherited cases [41].

Summary of the invention

The present invention now reveals that the unusual high concentration of Alu-elements in the BRCA1 gene intronic regions [11] favors the induction of large genomic deletions and inversions in a situation of increased genomic instability although other mechanisms leading to these mutations may also play significant roles. The present invention

thus provides a diagnostic test kit (and means and methods) for determining mutations, especially deletions of relatively large stretches of nucleotides in genes associated with hereditary types of cancer, in particular such mutations (deletions of relatively large stretches of nucleotides) in the BRCA1 gene. Such mutations are difficult, if not impossible, to detect by the current[ly] PCR-based approach (if their occurrence or the site thereof is unknown) using genomic DNA as template, which has been most widely applied to establish the current mutation spectrum of BRCA1. - -

Please move the section entitled "**Brief description of the drawings**" which extends from page 14 onto page 15, to follow the section entitled "**Summary of the invention**" and precede the section entitled "**Detailed description of the invention**" at page 8.

In the claims

Please cancel claims 1-14 and add new claims 15-55 as follows:

15. (New) A diagnostic test kit for detecting the presence of or predisposition for breast cancer, wherein a means is provided for detecting a deletion of a stretch of nucleotides from a BRCA1 gene in a sample, wherein said deletion comprises at least a major part of any one or all of exons 13, 14, 15 and 16, or at least a major part of exon 22.

16. (New) A diagnostic test kit according to claim 15, wherein the means comprises at least one probe for hybridization.
17. (New) A diagnostic test kit according to claim 15, wherein the means comprises the necessary elements for Southern blotting.
18. (New) A diagnostic test kit according to claim 16, wherein the probe comprises a sequence complementary to sequences on both sides of the deletion in the BRCA1 gene.
19. (New) A diagnostic test kit according to claim 17, wherein the necessary elements for Southern blotting comprises a probe, the probe comprising a sequence complementary to sequences on both sides of the deletion in the BRCA1 gene.
20. (New) A diagnostic test kit according to claim 15, wherein the deletion comprises all of one or more of exons 13, 14, 15, 16 or 22 of the BRCA1 gene.
21. (New) A diagnostic test kit according to claim 16, wherein the deletion comprises all of one or more of exons 13, 14, 15, 16 or 22 of the BRCA1 gene.
22. (New) A diagnostic test kit according to claim 17, wherein the deletion comprises all of one or more of exons 13, 14, 15, 16 or 22 of the BRCA1 gene.
23. (New) A diagnostic test kit according to claim 18, wherein the deletion comprises all of one or more of exons 13, 14, 15, 16 or 22 of the BRCA1 gene.

24. (New) A diagnostic test kit according to claim 19, wherein the deletion comprises all of one or more of exons 13, 14, 15, 16 or 22 of the BRCA1 gene.
25. (New) A diagnostic test kit according to claim 15, wherein the deletion comprises a frame shift and/or a termination codon.
26. (New) A diagnostic test kit according to claim 16, wherein the deletion comprises a frame shift and/or a termination codon.
27. (New) A diagnostic test kit according to claim 17, wherein the deletion comprises a frame shift and/or a termination codon.
28. (New) A diagnostic test kit according to claim 18, wherein the deletion comprises a frame shift and/or a termination codon.
29. (New) A diagnostic test kit according to claim 19, wherein the deletion comprises a frame shift and/or a termination codon.
30. (New) A diagnostic test kit according to claim 20, wherein the deletion comprises a frame shift and/or a termination codon.
31. (New) A diagnostic test kit according to claim 15, wherein the deletion comprises a deletion of a stretch of nucleotides between two ALU-elements.
32. (New) A diagnostic test kit according to claim 16, wherein the deletion comprises a deletion of a stretch of nucleotides between two ALU-elements.

33. (New) A diagnostic test kit according to claim 17, wherein the deletion comprises a deletion of a stretch of nucleotides between two ALU-elements.
34. (New) A diagnostic test kit according to claim 18, wherein the deletion comprises a deletion of a stretch of nucleotides between two ALU-elements.
35. (New) A diagnostic test kit according to claim 19, wherein the deletion comprises a deletion of a stretch of nucleotides between two ALU-elements.
36. (New) A diagnostic test kit according to claim 20, wherein the deletion comprises a deletion of a stretch of nucleotides between two ALU-elements.
37. (New) A diagnostic test kit according to claim 25, wherein the deletion comprises a deletion of a stretch of nucleotides between two ALU-elements.
38. (New) A probe for use in a diagnostic test kit for detecting the presence of or predisposition for breast cancer, wherein a means is provided for detecting a deletion of a stretch of nucleotides from a BRCA1 gene in a sample, and wherein the deletion comprises at least a major part of any one or all of exons 13, 14, 15, and 16, or at least a major part of exon 22; said probe comprising a nucleotide sequence which is a fusion of two ALU elements of the BRCA1 gene.
39. (New) A probe for use in a diagnostic test kit according to claim 38, wherein the means comprises at least one probe for hybridization, the probe comprising a nucleotide sequence which is a fusion of two ALU elements of the BRCA1 gene.

40. (New) A probe for use in a diagnostic test kit according to claim 38, wherein the means comprises the necessary elements for Southern blotting, comprising a nucleotide sequence which is a fusion of two ALU elements of the BRCA1 gene.
41. (New) A probe for use in a diagnostic test kit according to claim 18, comprising a nucleotide sequence which is a fusion of two ALU elements of the BRCA1 gene.
42. (New) A probe for use in a diagnostic test kit according to claim 19 comprising a nucleotide sequence which is a fusion of two ALU elements of the BRCA1 gene.
43. (New) A probe for use in a diagnostic test kit according to claim 20 comprising a nucleotide sequence which is a fusion of two ALU elements of the BRCA1 gene.
44. (New) A probe for use in a diagnostic test kit according to claim 25 comprising a nucleotide sequence which is a fusion of two ALU elements of the BRCA1 gene.
45. (New) A probe for use in a diagnostic test kit according to claim 31 comprising a nucleotide sequence which is a fusion of two ALU elements of the BRCA1 gene.
46. (New) A probe for use in a diagnostic test kit according to claim 15, wherein the deletion comprises at least a major part of any one or all of exons 13, 14, 15, and 16, or at least a major part of exon 22 comprises, and wherein the probe is a fusion product of two sequences adjacent to the site of a deletion of a stretch of nucleotides.
47. (New) A probe for use in a diagnostic test kit according to claim 16, which is a fusion product of two sequences adjacent to the site of a deletion of a stretch of nucleotides.

48. (New) A probe for use in a diagnostic test kit according to claim 17, which is a fusion product of two sequences adjacent to the site of a deletion of a stretch of nucleotides.
49. (New) A probe for use in a diagnostic test kit according to claim 18, which is a fusion product of two sequences adjacent to the site of a deletion of a stretch of nucleotides.
50. (New) A probe for use in a diagnostic test kit according to claim 19, which is a fusion product of two sequences adjacent to the site of a deletion of a stretch of nucleotides.
51. (New) A probe for use in a diagnostic test kit according to claim 20, which is a fusion product of two sequences adjacent to the site of a deletion of a stretch of nucleotides.
52. (New) A probe for use in a diagnostic test kit according to claim 25, which is a fusion product of two sequences adjacent to the site of a deletion of a stretch of nucleotides.
53. (New) A probe for use in a diagnostic test kit according to claim 31, which is a fusion product of two sequences adjacent to the site of a deletion of a stretch of nucleotides.
54. (New) A probe for use in a diagnostic test kit according to claim 38, which is a fusion product of two sequences adjacent to the site of a deletion of a stretch of nucleotides.
55. (New) A method of determining the presence in a sample of a nucleic acid derived from a BRCA1 gene having a deletion of a stretch of nucleotides, comprising contacting said sample with at least one probe which alone or together with a second means for detecting said deletion of a stretch of nucleotides from a BRCA1 gene, distinguishes between BRCA1 genes having said deletion and BRCA1 genes not

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having said deletion, allowing hybridization between said probe and said nucleic acids to form a hybridization product and identifying the hybridization product, wherein said deletion comprises at least a major part of any one or all of exons 13, 14, 15, and 16, or at least a major part of exon 22.

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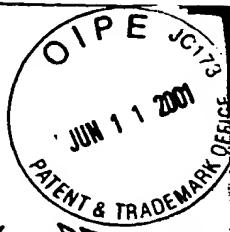


EXHIBIT 1



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The

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Abbreviations

